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EXAMINER

ART UNIT	PAPER NUMBER
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Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/054,233	Applicant(s) Rice et al.
Examiner Michael Pender	Group Art Unit 2762



Responsive to communication(s) filed on Aug 25, 2000.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-66 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-13, 15-29, and 31-66 is/are rejected.

Claim(s) 14 and 30 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. **Claims 1-66** have been examined and rejected.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 54-57** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 54:

The method of claim 1, further comprising the steps of
- receiving the electronic message from the source in a first data format; and
- converting the electronic message from the first data format to an electronic message having a second data format.

Claim 54 is rejected because Applicant does not teach how to convert an electronic message from one data format to another. **Claims 55-57** are rejected as dependent on rejected claim 54.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. **Claims 1-13, 15-29, 31-66** are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The claimed invention is clearly anticipated by Microsoft's "Microsoft Outlook 97 (Version 8.0)," which was on sale and in public use on June 5, 1995. Applicants claim:

Claim 1:

A method for automatically processing a non-interactive electronic message using a computer, comprising the steps of:

- receiving the electronic message from a source;*
- interpreting the electronic message using a rule base and case base knowledge engine; and*
- classifying the electronic message as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator.*

Microsoft teaches various strategies for organizing email, including the use of a **Rules Wizard**.

The **Rules Wizard** explicitly teaches interpreting the message and classifying the message for automated response, including filing in a designated folder, filing a copy in the designated folder, deleting it, forwarding it to another address or addresses, replying to it, or providing user

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notification. Microsoft further teaches automated processing of emails, such as for gathering opinions and automated processing of the opinions to track the result of the vote.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 2:

The method of claim 1, further comprising the step of retrieving one or more predetermined responses from a repository for automatic delivery to the source when the classification step indicates that the electronic message can be responded to automatically.

Microsoft *explicitly* teaches the use of a template, from a library of templates, to automatically reply to a message, the equivalent of Applicant's "*further comprising the step of retrieving one or more predetermined responses from a repository for automatic delivery to the source when the classification step indicates that the electronic message can be responded to automatically*" limitation. *See Getting Results*, page 379.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 3:

The method of claim 1, further comprising the steps of
- retrieving one or more predetermined responses from a repository, the predetermined responses being proposed for delivery to the source;
- forwarding the electronic message and the predetermined response to the human operator when the classification step indicates that a response to the electronic message requires assistance from a human operator; and
- delivering the predetermined response to the source when the human operator deems the response appropriate.

Microsoft *explicitly* teaches the use of a template, from a library of templates, to automatically reply to a message, the equivalent of Applicant's "*retrieving one or more predetermined*

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responses from a repository, the predetermined responses being proposed for delivery to the source" limitation. *See Getting Results*, page 379.

Microsoft *explicitly* teaches the use of the **Rules Wizard** to automatically forward a message to one or more email addresses, the equivalent of Applicant's "*forwarding the electronic message and the predetermined response to the human operator when the classification step indicates that a response to the electronic message requires assistance from a human operator*" limitation.

Id.

As noted previously, Microsoft *explicitly* teaches the use of the **Rules Wizard** to automatically reply to a message using a template, the equivalent of Applicant's "*delivering the predetermined response to- the source when the human operator deems the response appropriate*" limitation.

Id.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 4:

The method of claim 3, further comprising the step of further categorizing the electronic message into at least one of a plurality of sub-categories based on subject matter content of the electronic message.

Microsoft teaches the use of "folders" for organizing email messages according to the user's preference. Microsoft *explicitly* teaches the user of the **Rule Wizard** to file the original message, or a copy of the mail message, in designated folders.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 5:

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The method of claim 4, wherein the sub-categories include product service subject matter and product sales subject matter.

The Examiner notes that the proposed “*sub-categories*” merely relate a *proposed use* for the invention, not a functional limitation of the invention. As such, the “*sub-categories*” do not further distinguish the claimed invention from prior art. Claim 5 is rejected for the same reasons as claim 4.

Claim 6:

The method of claim 4, further comprising the step of prioritizing the sub-categorized electronic message into at least one of a plurality of priorities based on the subject matter content of the electronic message wherein a higher priority indicates that the human operator should process the associated electronic message before processing lower prioritized electronic messages.

The Examiner notes that *Outlook for Office 97* supports three message priorities: *Low Importance, Normal Importance, and High Importance*, the equivalent of Applicant’s “*further comprising the step of prioritizing the sub-categorized electronic message into at least one of a plurality of priorities based on the subject matter content of the electronic message wherein a higher priority indicates that the human operator should process the associated electronic message before processing lower prioritized electronic messages*” limitation.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 7:

The method of claim 6, wherein the plurality of priorities of a product service category include at least one of (i) fraud and lost products; (ii) sensitive information; (iii) general information; and (iv) user comments.

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The Examiner notes that the listed “*priorities*” merely relate a *proposed use* for the invention, not a functional limitation of the invention. As such, the “*priorities*” do not further distinguish the claimed invention from prior art. Claim 7 is rejected for the same reason as claim 6.

Claim 8:

The method of claim 7, wherein the listed priorities are in order from highest to lowest priority.

The Examiner notes that messages may be *sorted* according to priority by clicking the “!” column to select the message priority as the sort index. *See Getting Started*, page 376.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 9:

The method of claim 6, wherein the plurality of priorities of a product sales sub-category include promotional content, request for services, and general questions and lengthy messages.

The Examiner notes that the listed “*priorities*” merely relate a *proposed use* for the invention, not a functional limitation of the invention. As such, the “*priorities*” do not further distinguish the claimed invention from prior art. Claim 9 is rejected for the same reason as claim 6.

Claim 10:

The method of claim 9, wherein the listed priorities are in order from highest to lowest priority.

The Examiner notes that messages may be *sorted* according to priority by clicking the “!” column to select the message priority as the sort index. *See Getting Started*, page 376.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 11 is rejected for the same reasons as claim 1.

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Claims 12, 13 are rejected for the same reasons as claim 3.

Claim 15:

The method of claim 1, wherein the electronic message is received over an electronic data communications channel.

By **definition**, e-mail is transmitted and received over an electronic data communications channel. The limitation is inherent in Microsoft's *Outlook for Windows 97*.

Claim 15 is rejected for the same reasons as claim 1.

Claim 16:

The method of claim 15, wherein the electronic data communications channel is the Internet.

Microsoft **explicitly** teaches the use of e-mail on the Internet. See *Getting Started*, page 380.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 17:

The method of claim 15, wherein the electronic message is an electronic mail (E-mail) [sic] message.

Microsoft **explicitly** teaches the use of e-mail. See *Getting Started*, page 380. Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

Claim 18:

A method for automatically processing an electronic mail (E-mail) message, comprising the steps of.

- *receiving the E-mail from a source over an electronic data communications channel;*
- *interpreting the E-mail using a rule base and case base knowledge engine; and*

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- classifying the E-mail as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator; wherein when the classification indicates that the E-mail can be responded to automatically, the method further includes the steps of
 - retrieving one or more predetermined responses from a repository;
 - formulating an E-mail response from the predetermined response; and
 - transmitting the E-mail response to the source over the data communications channel.

Microsoft teaches the use of a *Rule Wizard* to generate a hierarchy of “rules” the equivalent of Applicant’s “rule base” limitation. Microsoft also teaches the use of folders to hold e-mail messages, the equivalent of Applicant’s “case base” limitation.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

Claims 19-21 are rejected for the same reasons as claim 3.

Claim 22:

The method of claim 21, wherein the step of interpreting the electronic message further includes the steps of

- producing a case model of the electronic message including a set of predetermined attributes for identifying specific features of the electronic message;
- detecting at least one of text, combinations of text, and patterns of text of the electronic message using character matching;
- flagging the attributes of the case model which are detected in the electronic message; and
- classifying the electronic-message as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator, the classification being performed in accordance with the flagged attributes.

The Examiner interprets that the claimed invention parses incoming messages for comparison against the message-processing rules in the rule base. The Examiner interprets that the cited limitations are necessarily inherent features of Microsoft’s *Outlook for Office 97* which are required for enablement.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

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Claims 23-30 are rejected for the same reasons as claim 22.

Claim 31:

A system for automatically processing a non-interactive electronic message received from a source, the system comprising:

- a server for transmitting and receiving electronic messages over a communications channel;*
- an inbox storage device for storing incoming electronic messages;*
- a knowledge engine including a rule base and a case base, the case base having a plurality of stored cases representing past received electronic messages;*
- a pre-processor for receiving the electronic message and interpreting the electronic message using the rule base;*
- a searching device for searching the electronic message and the case base to retrieve a stored case from the case base which most closely matches the electronic message;*
- a classifier for classifying the electronic message into at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator.*

The Examiner notes the introduction of the “*inbox*” limitation. Microsoft teaches the use of an “*inbox*” the equivalent of Applicant’s “*inbox*” limitation. All other limitations have already been addressed in this office action.

Microsoft’s *Outlook for Office 97* *clearly anticipates* the claimed invention.

Claim 32-40 are rejected for the same reasons as claim 31.

Claims 41-48 are rejected for the same reasons as claim 3.

Claims 49-53 are rejected for the same reasons as claim 22.

Claim 59:

The method of claim 1, wherein the electronic message includes fixed data.

The Examiner notes that e-mail messages *inherently* include fixed data, such as header fields.

Claim 59 is rejected for the same reasons as claim 1.

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Claim 60:

The method of claim 1, wherein the electronic message includes variable data.

The Examiner notes that e-mail messages *inherently* include variable data, such as a “from” field, “to” field, “subject” field and message body. **Claim 60** is rejected for the same reasons as claim 1.

Claim 61 is rejected for the same reasons as claim 3.

Claim 62 is rejected for the same reasons as claim 59.

Claim 63 is rejected for the same reasons as claim 60.

Claim 64 is rejected for the same reasons as claim 3.

Claim 65 is rejected for the same reasons as claim 59.

Claim 66 is rejected for the same reasons as claim 60.

Response to Arguments

6. Applicant's arguments filed August 25,2000 have been fully considered but they are *not persuasive*.

Rejections under 35 U.S.C. § 112:

Claims 54-57 stand rejected because the written description is inadequate to enable one of ordinary skill in the art to make and/or use the invention. Applicant argues:

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Applicant respectfully submits that systems and methods for character recognition and for converting voice data to digital text (as well as for numerous other conversions of data from a first format to a second format) are well known in the art. A detailed description of such systems is therefore not necessary to enable one skilled in the art to make and/or use the claimed invention after reading the application as filed.

Applicant's mere allegation of enablement is not persuasive. The Examiner disagrees that enabled systems and methods for converting voice data to digital text were "*well known in the art*" at the time of Applicant's invention. Applicant has presented no **evidence** to the contrary. If enabling systems and methods for character recognition and converting voice data to digital text were **well known** at the time of Applicant's invention, then Applicant should have no difficulty producing evidence of such systems. However, even assuming that the claimed invention requires no more enablement than already present in the prior art, Applicant fails to identify any specific "*systems and methods for character recognition and digital text*" that would actually enable the invention when filed. Applicant **clearly fails to enable** one of ordinary skill in the art to make or use the claimed invention without undue experimentation.

Rejections under 35 U.S.C. § 101:

The Examiner withdraws the rejection in view of Applicant's amendment. The Examiner observes that Applicant's amendment only alters the preamble of the claims. However, the Examiner concludes that the limitations related to "*receiving*", "*interpreting*" and "*classifying*" limitations should be interpreted as relating back to the "*processing*" language in the preamble; otherwise, the amendment cannot be given any patentable weight.

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Rejections under 35 U.S.C. § 102:

The Examiner rejected claims 1-13, 15-29 and 31-66 as *clearly anticipated* by Microsoft’s “Outlook”, not merely “*anticipated*” as stated by Applicant’s Attorney. Applicant argues:

...Outlook does not disclose or suggest the use of a case base knowledge engine. Therefore, claim 1 is allowable over the reference. Furthermore, claims 2-13, 15-17 and 54-60 are also allowable as they depend from allowable claim 1, and withdrawal of the § 102(b) rejection as to those claims is respectfully requested.

As the Examiner explained in the previous Office Action, the use of folders in Outlook to hold email messages is the equivalent of Applicant’s “*case base*” limitation. Folders are used to organize similar messages, the equivalent of a case base. In *Outlook*, the user reviews messages in each folder to develop the *rules* that are used by the *Rule Wizard* to interpret and classify email messages. *Outlook clearly anticipates* Applicant’s “*interpreting the electronic message using a rule bas and case base knowledge engine*” limitation.

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Examiner's Comment

7. Applicant's invention, as yet not claimed, apparently relates to automated development of case models for processing of email. The Examiner *agrees* that *Outlook* does not teach fully automated derivation of case models. However, the claimed invention contains no language directed to such a feature. As Applicants were *explicitly advised* in the previous Office Action, an examiner is prohibited from reading limitations present in the specification into the claims.

See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Pender whose telephone number is (703) 308-0147. The Examiner can normally be reached on Monday - Friday from 8:15 A.M. to 4:45 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark Powell can be reached at (703) 305-9703. Any response to this office action should be mailed to:

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or faxed to:

(703) 308-9051, (for formal communications intended for entry), or:

(703) 308-1396, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).



Michael Pender

November 5, 2000



MARK POWELL
SUPERVISORY PATENT EXAMINER
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